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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/654,516	09/01/2000	Louise Farrand	MERCK-2155	6056

23599 7590 03/29/2005

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EXAMINER

OH, TAYLOR V

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 03/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/654,516

Applicant(s)

FARRAND ET AL.

Examiner

Taylor Victor Oh

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 February 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-10 and 17-20.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
SEE. PAGES 2-5.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____.
13. ☐ Other: _____.

It is noted that applicants have filed an Amendment after the Final Rejection on 2/03/05; The proposed amendment will be entered ;however, it is not in a condition for allowance.

The Status of Claims

Claims 1-10, and 17-20 are pending.

Claims 1-10, and 17-20 have been rejected.

Claims 11-16 have been canceled.

Claim Rejections - 35 USC § 112

1. Applicants' argument filed 2/03/05 have been fully considered but are not persuasive.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of Claims 1-10, and 17-20 under the second paragraph of 35 U.S.C. 112 has been maintained due to applicants' failure to modify the claims in the amendment.

Applicants' Argument

Applicants argue the following issues:

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- a. Although the scope of the “polymerizable group” and “mesogenic group” terms is broad, there is no question that one of ordinary skill in the art would reasonably know or can reasonably determine what the scope is; this is not even disputed in the Office Action;
- b. Claims containing terms such as , plastic, solvent, polymer, substrate don't render them indefinite;
- c. Applicants do not see the applicability of the “reach-through arguments” because it has been focused in the context of biotech-based claims and situations unique to that technology;
- d. Applicants note that the terms “polymerizable group” and “mesogenic group” are functional terms rather than defining an exact structure; the law is well-established that claim terms are not improper merely because they are functional terms;
- e. One of ordinary skill in the art would be able to reasonably determine the metes and bounds of these terms and the claims containing them, they would be able to reasonably determine whether a group is a polymerizable group or a mesogenic group.

Applicants' arguments have been noted, but the arguments are not persuasive.

First, regarding the first, third, fourth, and fifth arguments , the Examiner has noted applicants' arguments. However, there is no general structural chemical formula for the polymerizable groups and mesogenic groups as parts of the claim formula I which needs to describe distinguishing identifying characteristics sufficient show that the applicant was in possession of the claimed invention, and the claim ,as a whole, may not be adequately described

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where the invention is described solely in terms of compounds coupled with their functional terms. The claims are directed to the compound claims; the claimed compounds of the formula I require a definite outline of the metes and bounds of the chemical structure; without them, the formula I is surely indefinite.

The meanings of both “polymerizable group” and the “mesogenic group” surely cover a large number of possible groups; because of this aspect, they do read on the Reach-Through Claim regardless of where the notion of the Reach-Through Claim came from in the first place; furthermore, applicants did not invent all the “polymerizable group” and the “mesogenic group” known in the art. Moreover, applicants are eager to claim all the “polymerizable group” and the “mesogenic group” known in the art as well as the future “polymerizable groups” and “mesogenic groups”, which have not been discovered yet, as if they were their own inventions. The present inventors have no right to do that just because applicants have mentioned some of the examples for the polymerizable group and the mesogenic group in the specification.

In order to overcome this rejection, the examiner recommends to add the specific “polymerizable groups” and “mesogenic groups” to the claims.

Second, regarding the second argument, the Examiner has noted applicants' arguments. However, it depends on how each of the terms is and described and claimed in the invention. Therefore, applicants' argument is irrelevant to the issue.

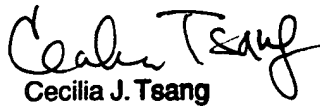
Therefore, the rejection of the claims has been maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 571-272-0689. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Taylor Victor Oh
3/23/05


Cecilia J. Tsang
Supervisory Patent Examiner
Technology Center 1600